



MAY 30 2001  
UNITED STATES PATENT AND TRADEMARK OFFICE

#7

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

William S. Frommer  
Frommer, Lawrence & Haug  
745 Fifth Avenue  
New York, NY 10151

In re Application of	:	DECISION
OKAYASU et al.	:	
Application No.: 09/581,689	:	
PCT No.: PCT/JP98/05785	:	
Int. Filing Date: 21 December 1998	:	
Priority Date: 19 December 1997	:	
Attorney Docket No.: 450101-4689	:	
For: DEVICE CONTROL APPARATUS AND	:	
METHOD	:	

This is a decision on applicants' "REQUEST FOR RECONSIDERATION" filed in the United States Patent and Trademark Office (USPTO) on 26 October 2000.

### **BACKGROUND**

On 21 December 1998, applicants filed international application PCT/JP98/05785, which claimed a priority date of 19 December 1997. A copy of the international application was communicated to the USPTO from the International Bureau on 01 July 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 July 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 19 June 2000.

On 15 June 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the international application into English.

On 19 July 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that the translation of the international application into English was defective because the number of claims in the international application and the number of claims in the translation were not the same, that a translation of the international application as well as the processing fee under 37 CFR 1.492(f) were required, and that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) as well as the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were also required. The

NOTIFICATION set a one-month extendable period for reply.

On 26 September 2000, applicants submitted a declaration of the inventors, a check for the surcharge in the amount of \$130.00, and "the English translation of the PCT application filed 21 December 1998 in Japan."

On 04 October 2000, the USPTO mailed a NOTIFICATION OF A DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the translation of the international application into English filed 26 September 2000 was defective and that while the surcharge under 37 CFR 1.492(e) had been paid, the processing fee under 37 CFR 1.492(f) had not. The NOTIFICATION OF A DEFECTIVE RESPONSE was accompanied by a NOTICE OF DEFECTIVE TRANSLATION (Form PCT/DO/EO/913) which stated that several of the claim dependencies had been changed in the translation and cited as an example that claim 5 is dependent on claim 4 in the English translation but not in original claim 5.

On 26 October 2000, applicants submitted the instant "REQUEST FOR RECONSIDERATION" requesting that the NOTIFICATION OF A DEFECTIVE RESPONSE and NOTICE OF DEFECTIVE TRANSLATION mailed 04 October 2000 be withdrawn. The request was accompanied by a copy of the claims as originally filed in the international application with the dependency of claim 5 translated.

### DISCUSSION

The "REQUEST FOR RECONSIDERATION" filed 26 October 2000 states that the English translation submitted 26 September 2000 is a true and accurate translation of the international application. The translation of the dependency of claim 5 shows claim 5 to be dependent on claim 4. Thus, it appears that the NOTICE OF DEFECTIVE TRANSLATION mailed 04 October 2000 was incorrect in stating that several of the claim dependencies had been changed. Accordingly, the NOTIFICATION OF A DEFECTIVE RESPONSE and the NOTICE OF DEFECTIVE TRANSLATION mailed 04 October 2000 are hereby VACATED.

However, it is noted that the translation of the international application filed 26 September 2000 is defective because it did not include a translation of the drawings as originally filed. A paper filed 15 June 2000 with the heading "AMENDMENT (AMENDMENT under Article 11)" states that Figures 1, 4, 6, 10, 11, 13, 14, 21, 28, 30, 31, 35, and 37 were amended in accordance with their explanations in the description. However, when a translation of the international application as originally filed (rather than as amended) was submitted on 26 September 2000, a copy of the translation of the drawings as originally filed was not submitted.

### CONCLUSION

The NOTIFICATION OF A DEFECTIVE RESPONSE and the NOTICE OF

DEFECTIVE TRANSLATION, both mailed 04 October 2000, are hereby VACATED.

Since the reply filed 26 September 2000 appears to have been bona fide, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to provide a translation of the international application as filed into English, including the drawings, and to provide the processing fee under 37 CFR 1.492(f) in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer

PCT Legal Examiner

PCT Legal Affairs

Office of Patent Cooperation Treaty

Legal Administration

Telephone: (703) 308-2066

Facsimile: (703) 308-6459